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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/547,223      | 04/11/2000  | Kenichi Hiraoka      | 1636-0021-0         | 4699             |

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EXAMINER

CORBIN, ARTHUR L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1761

DATE MAILED: 02/14/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09547223

Applicant(s)

Hirakawa

Examiner

Arthur L Corbin

Group Art Unit

1761

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 12-10-01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the original disclosure for : the limitation in claim 8<sup>since</sup> The specification (page 9) indicates that "of no less"<sup>(claim 8)</sup> should be "higher"; or the limitation in claim 26, which is not supported by page 20 of the spec. Corrections are required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 11, 12, 14 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is<sup>is</sup> antecedent basis in claim 1 for "the fry" (claims 9 and 17-19) or "the treated fry" (claims 11, 12, 14 and 16-18).

Claim 18 is indefinite since it is not clear which steps claimed in claim 18 occur "after" the washing or neutralizing (claim 18, last line). Corrections are required without new matter.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sogabe (cols. 2-6) taken with or without Bender et al (cols. 3-5).

Sogabe discloses treating a crustacean, after removal from the ocean, i.e. salt water, to prevent dark black spots <sup>from</sup> appearing on the surface thereof. A crustacean, after the shell is removed, is contacted with an alkali as claimed by applicant and with a sodium phosphate at a pH of 10-14 for 1 second to 60 minutes at 0°C To 70°C, and then washed with water or neutralized with an organic or inorganic acid for 1 to 30 minutes to lower the pH to 7.5. After neutralizing, the crustacean is washed with water and treated with a liquid containing salt and sugar. Subsequently, the crustacean is vacuum packed and frozen. It is conventional to prepare crustaceans for consumption by boiling in water. Without Bender et al, it would have been obvious to perform the process of Sogabe on whole fish since a crustacean without its shell and a whole fish are both well known seafoods having an outer flesh or skin layer and which can be prepared for consumption in a similar manner. With Bender et al, <sup>it</sup> would have been obvious to perform the process of Sogabe on whole fish since it is old to treat whole fish or crustacean with an alkali, i.e. a sodium phosphate as disclosed in Sogabe, and then wash or neutralize with an acid, as evidenced by

Bender et al. Alternatively, it would have been obvious to substitute one of applicant's claimed alkali solutions for the sodium phosphate in Bender et al to treat the whole fish or crustacea<sup>8</sup> therein since such alkali solutions and sodium phosphate are well known and viable alternative<sup>5</sup> in treating crustacea<sup>8</sup>, which are thereafter washed or acid neutralized, as evidenced by Sogabe.

7. Applicant's arguments with respect to claims 1-6 submitted December 10, 2001 have been considered but are moot in view of the new ground(s) of rejection.
8. The abstract of the disclosure is objected to because it is not limited to one paragraph. Correction is required. See MPEP § 608.01(b).
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can normally be reached on Tuesday - Friday from 9:30 AM to 7:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Arthur Corbin/om

February 13, 2002

  
ARTHUR L. CORBIN  
PRIMARY EXAMINER  
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